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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,926	03/20/2002	Timo Juhani Kangas	1329/OK329USO	2678
7278	7590	12/15/2005	EXAMINER	
DARBY & DARBY P.C. P. O. BOX 5257 NEW YORK, NY 10150-5257			ZURITA, JAMES H	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 12/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/088,926

Applicant(s)

KANGAS, TIMO JUHANI

Examiner

James H. Zurita

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09/13/05.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Prosecution History***

On 20 March 2002, applicant filed the instant application, which is a national stage entry of PCT/FI00/00822 International Filing Date: 09/27/2000, filed in Finland. Applicant claims priority to application 129992084, filed on 09/29/1999 in Finland.

On 26 February 2005, in a first Office Action, the Examiner rejected claims 1-6, 8-10 as anticipated by Goldhaber (US 5,794,210). Claim 7 was rejected as unpatentable over Goldhaber.

On 5 June 2005, applicant amended claims 1-10 and added claims 11-13.

On 30 August 2005, the Examiner found applicant's response to be not fully responsive and provided applicant with a 30-day period to respond.

On 13 September 2005, applicant filed a response.

The present Office Action is in response to applicant's amendment.

### ***Response to Amendment***

On 13 September 2005, applicant amended each of claims 1-10 and added claims 11-13. Claims 1-13 are pending and will be examined.

### ***Claim Objections***

In claim 3, "...*intentionally* provided by said certain recipient..." renders the claim being indefinite for failing to particularly point out and distinctly claim the subject

matter which applicant regards as the invention. The claim appears to require an inquiry into a recipient's state of mind to determine *intent*.

### ***Claim Rejections - 35 USC § 112***

Claims 1, 8, 9, 11 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims refer to "...preliminary order for crediting the accounts..." The disclosures refer to preliminary several times but does not provide details, e.g.,

At step 303 the service provider's terminal transmits to the *account* server a ***preliminary order*** for crediting the *accounts* of the subscribers that appear on the final list of intended recipients. The amount by which the *accounts* should be credited can be freely decided by the service provider. The ***preliminary*** nature of the order means that the actual crediting is not yet accomplished, because there is no evidence about the intended recipients actually receiving the information or service to be transmitted. If the database server has not provided the service provider with *account* indicators, step 303 is omitted.

Those *embodiments* where the service provider transmits a ***preliminary*** crediting order to the *account* server before transmitting the information or service to the subscriber terminals are more advantageous than the *embodiment* of Fig. 4 in the sense that they reduce the service provider's chance for cheating: nothing actually guarantees that the service provider will actually transmit the crediting order in the *embodiment* of Fig. 4. On the other hand the *embodiment* of Fig. 4 has the advantage that...

For Examination purposes, the Examiner will interpret the phrase "...preliminary order for crediting the accounts..." as a maximum amount or a fixed amount that a provider is willing to compensate those customers that access the information.

### ***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-6, 8-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Goldhaber et al. (US 5,794,210).

***As per claims 1 and 8,*** Goldhaber discloses methods for distributing information and services through networks, including the steps of:

composing a piece of information or service to be distributed through a computer or cellular network. See, for example, references to advertisements, products and services, at least Col. 1, lines 15-61.

compiling a list of intended recipients. See at least references to targeting an audience by demographic profiles, for example, Col. 2, lines 35-49. see also references to explicit target audience, as in the Abstract, explicit delineation of target audience, as in Col. 5, line 25-Col. 6, line 2. see also references to demographic routing, at least Col. 5, lines 17-55.

transmitting through the computer or cellular network a preliminary order for crediting accounts associated with the intended recipients. See, for example, references to fixed price information, as in Fig. 2 and related text.

releasing said piece of information or service so that the piece of information or service becomes accessible to the recipients appearing on said list. See, for example, references to transmitting information over a network to target audience, at least Col. 10, lines 8-38.

as a response to an indication of a certain recipient having accessed said piece of information or service, crediting an account associated with said certain recipient. See at least Fig. 10, reference 60(c), showing crediting to an account.

**As per claim 2**, Goldhaber discloses that crediting an account associated with a recipient may include a substep of identifying an account representing the rights of said certain recipient to use certain services through said network. See, for example, at least references to crediting a consumer's account, at least Col. 6, line 24-Col.7, line 18.

**As per claim 3**, Goldhaber discloses that crediting an account associated with a recipient may include a substep of identifying an *account* the identifier of which has been intentionally provided by said certain recipient. See, for example, at least references to credit card or bank accounts or specialized accounts provided by a recipient, Col. 7, lines 47-62.

**As per claim 4**, Goldhaber discloses that releasing said piece of information or service (advertisement, for example) may comprise a substep of indicating to at least part of the recipients appearing on said list that accessing said piece of information or service will cause a certain **account** associated with said certain recipient to be credited. See, for example, references to icons that indicate to recipients [selected on the basis of demographics, for example] that accessing the advertisement will cause a user's account to be credited, as in Col. 7, lines 47-61.

**As per claim 5**, Goldhaber discloses that a step of releasing an advertisement may comprise a substep of transmitting said piece of information or service to a number of subscriber terminals. See, for example, references to target audience, as in claims 1, 4, above. See also references to consumer/subscriber demographic profiles, as in Col. 6, lines 46-67.

**As per claim 6**, Goldhaber discloses that a step of releasing an advertisement may comprise substep(s) of

storing said piece of information or service to a place which is accessible for subscriber terminals through a network. See, for example, at least Fig. 10, which shows various types of storage devices for storing advertising information that is distributed through network 102.

transmitting to a number of subscriber terminals an indication of said piece of information or service being available at said place. See, for example, at least references to lists of advertisements available to subscriber(s) at subscriber terminals. The indication may be in the form of a thumbnail view that permits a subscriber to select and view particular advertisements, as in Figs. 12, 13 and related text.

**As per claims 8-10**, Goldhaber discloses various databases and servers:

source of information or services See, for example, references to information services and servers, reference 106.

number of subscriber terminals. See, for example, at least references to consumer computers 104.

means for maintaining accounts associated with certain subscribers. See, for example, at least references to digital cash repository, Fig. 7 and related text.

means for transmitting through the computer or cellular network a preliminary order for crediting accounts associated with the intended recipients. See, for example, references to fixed price information, as in Fig. 2 and related text.

The consumer terminals 104 may be different from each other and may be contacted via various modes of transmission, including email, web pages, and others, according to consumer requirements. See, for example, at least Col. 13, lines 1-16, Col. 20, lines 56-67. See references to content delivery, at least Fig. 2, related text.

Goldhaber discloses, as in Figs. 1 and 7, database server, an account server, service or information server.

**As per claims 11 and 12**, Goldhaber discloses transmitting through the computer or cellular network a preliminary order for crediting accounts associated with the intended recipients. See, for example, references to fixed price information, as in Fig. 2 and related text.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 7 and 13** are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldhaber et al. (US 5,794,210).

**As per claim 7**, Goldhaber does not specifically disclose that crediting an account associated with said certain recipient comprises the substeps of defining the time it has taken for said indication to be received and crediting said *account* by an amount which is inversely proportional to said time. Goldhaber discloses the use of time-sensitive incentives such as coupons, in addition to credits to an account. It would have been obvious to one of ordinary skill in the art at the time the invention was made



to extend Goldhaber to disclose time-sensitive credits, perhaps based on a subscriber's response time. One of ordinary skill in the art at the time the invention was made would have been motivated to extend Goldhaber to disclose time-sensitive credits, perhaps based on a subscriber's response time for the obvious reason that the value of information is often greater when the information is first posted. Goldhaber provides an example, Fig. 14, of information concerning a 1994 Explorer. Such information would likely be of less value as more time passes. Therefore, an advertiser may pay less and less as time passes.

***As per claim 13***, Goldhaber discloses method for distributing information or services through a computer or cellular network, as in claim 1, above.

Goldhaber ***does not*** specifically disclose crediting an account by (a) ranking the order in which said certain recipient provides the reception indication relative to other of said intended recipients; and (b) crediting said account associated with said certain recipient based on the order ranking. As noted previously, and now admitted prior art, it is well known to reward early responders.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to extend Goldhaber to disclose (a) ranking the order in which said certain recipient provides the reception indication relative to other of said intended recipients; and (b) crediting said account associated with said certain recipient based on the order ranking, such as response time.

One of ordinary skill in the art at the time the invention was made would have been motivated to extend Goldhaber to disclose (a) ranking the order in which said certain

recipient provides the reception indication relative to other of said intended recipients; and  
(b) crediting said account associated with said certain recipient based on the order ranking for the obvious reason that the value of information is often greater when the information is first posted. Goldhaber provides an example, Fig. 14, of information concerning a 1994 Explorer. Such information would likely be of less value as more time passes. Therefore, an advertiser may pay less and less as time passes.

### ***Response to Arguments***

Applicant's comments concerning Priority are persuasive; no action is needed.

Rejection of claims 1-7 under 35 USC 101 are withdrawn in view of amendment.

In response to applicant's comments concerning Goldhaber, the the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., reducing a service provider's chances of cheating) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

A "traverse" is a denial of an opposing party's allegations of fact.<sup>1</sup> The Examiner respectfully submits that applicants' arguments and comments do not appear to traverse what Examiner regards as knowledge that would have been generally available to one of ordinary skill in the art at the time the invention was made. Even if one were to interpret applicants' arguments and comments as constituting a traverse, applicants' arguments and comments do not appear to constitute an adequate traverse because applicant has not specifically pointed out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. 27 CFR 1.104(d)(2), MPEP 707.07(a). An adequate traverse must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying Examiner's notice of what is well known to one of ordinary skill in the art. In re Boon, 439 F.2d 724, 728, 169 USPQ 231, 234 (CCPA1971).

If applicant does not seasonably traverse the well known statement during examination, then the object of the well known statement is taken to be admitted prior art. In re Chevenard, 139 F.2d 71, 60 USPQ 239 (CCPA 1943). MPEP 2144.03 Reliance on Common Knowledge in the Art or "Well Known" Prior Art. In view of applicant's failure to adequately traverse official notice, the following is admitted prior art::

...the value of information is often greater when the information is first posted. [ ] information would likely be of less value as more time passes. Therefore, an advertiser may pay less and less as time passes.

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<sup>1</sup> Definition of Traverse, Black's Law Dictionary, "In common law pleading, a traverse signifies a denial."

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Zurita whose telephone number is 571-272-6766. The examiner can normally be reached on 8a-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*JZ*  
**James Zurita**  
**Patent Examiner**  
**Art Unit 3625**  
7 December 2005

  
**WYNN W. COGGINS**  
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